

## **REMARKS**

Claims 1-95 were pending in this application. Applicants note with appreciation that the elected antibody sequences are free of the prior art. Applicants also note that the restriction requirement was made final and thus, claims 37, 56-72 and 76-95, drawn to non-elected species, were withdrawn from consideration. In view of their withdrawal from consideration, claims 37, 56-72 and 76-95 have been canceled, without prejudice to Applicants' rights to pursue the subject matter of the canceled claims in related applications. Applicants have also canceled claims 1-36, 38-55 and 73-75, without prejudice to Applicants' right to pursue the subject matter of the canceled claims in related applications, and added new claims 96-182, directed to the elected subject matter. Upon entry of this Amendment, claims 96-182 will be pending. The new claims are fully supported by the specification of the present application (see, *e.g.*, page 6, line 32 to page 7, line 10; page 8, line 31 to page 9, line 20; page 40, line 30 to page 41, line 17; page 43, line 33 to page 44, line 5; page 47, line 12 to page 52; page 60, line 1 to page 63, line 8; page 70, line 9 to page 72, line 14; page 74, line 31 to page 76, line 22; page 89, line 22 to page 90, line 31; and page 116, line 14 to page 117, line 30 of the specification), and do not constitute new matter.

Entry of the foregoing amendments and consideration of these remarks are respectfully requested.

### **1. THE OBJECTION TO THE CLAIMS SHOULD BE WITHDRAWN**

Claims 1, 4-35, 38, 40, 43-55 and 73-75 are objected to for reciting non-elected inventions. Applicants thank Examiner Chen for confirming on October 1, 2003 that claims 1, 4-35, 38, 40, 43-55 and 73-75 are objected to because of the recitation of non-elected sequences. Applicants have canceled claims 1, 4-35, 38, 40, 43-55 and 73-75, without prejudice. Accordingly, the objection to claims 1, 4-35, 38, 40, 43-55 and 73-75 is moot. Therefore, the objection to claims 1, 4-35, 38, 40, 43-55 and 73-75 cannot stand and should be withdrawn.

### **2. THE REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH, SHOULD BE WITHDRAWN**

Claims 1, 4-35, 38, 43, 45, 47, 49, 51, 53 and 73-75 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner contends that the recitation of the trademark "SYNAGIS®" renders claims 1, 4-35,

38, 43, 45, 47, 49, 51, 53 and 73-75 indefinite. Applicants have canceled claims 1, 4-35, 38, 43, 45, 47, 49, 51, 53 and 73-75, without prejudice and new claims 99, 100, 161 and 163 recite palivizumab, not "SYNAGIS®". Accordingly, Applicants respectfully assert that the rejection of claims 1, 4-35, 38, 43, 45, 47, 49, 51, 53 and 73-75 under 35 U.S.C. § 112, second paragraph, is moot. Therefore, the rejection of claims 1, 4-35, 38, 43, 45, 47, 49, 51, 53 and 73-75 under 35 U.S.C. § 112, second paragraph, cannot stand and should be withdrawn.

**3. THE DOUBLE PATENTING REJECTION  
SHOULD BE WITHDRAWN**

Claims 1 and 4 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1 and 180 of copending U.S. application Serial No. 09/724,531. Applicants have canceled claims 1 and 4, without prejudice. Accordingly, Applicants respectfully assert that the rejection of claims 1 and 4 under 35 U.S.C. § 101 is moot. Therefore, the rejection of claims 1 and 4 under 35 U.S.C. § 101 cannot stand and should be withdrawn.

**CONCLUSION**

Applicants believe that the present claims meet all the requirements for patentability. Entry of the foregoing amendments and remarks into the file of the above-identified application is respectfully requested. Withdrawal of all rejections and reconsideration of the amended claims are requested. An allowance is earnestly sought.

If any issues remain, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

Date: October 14, 2003

Anthony M. Inogna 35,203  
Anthony M. Inogna (Reg. No.)  
**PENNIE & EDMONDS LLP**  
1155 Avenue of the Americas  
New York, New York 10036-2711  
(212) 790-9090

By: Jennifer J. Chheda  
Reg No. 46,617